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09/817,278	03/27/2001	Paul Adams	618-979	7709

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PENNIE & EDMONDS LLP
1667 K STREET NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

FERKO, KATHRYN P

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PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/817,278
Filing Date: March 27, 2001
Appellant(s): ADAMS ET AL.

MAILED

MAR 24 2003

GROUP 3700

Brian Rothery
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 21, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief and none have been identified.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims claim 1 and dependent claims 2-6, 17, 18, 20 and 21 stand or fall together; dependent claims 7-8 stand or fall together; dependent claims 9-16 and 19 stand or fall together; independent claim 68 and dependent claims 69-71 and 74 stand or fall together; dependent claims 72-73 stand or fall together; and dependent claims 75-76 stand or fall together. However, appellant's brief does not include reasons for the grouping of the claims in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,199,865	Liang	4-1993
6,213,759	Sung	4-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Original claims 1-8, 17-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Liang in US Patent No. 5,199,865. This rejection is set forth in prior Office Action, Paper No. 5 and further as amended in Paper No. 15. Claims 9-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liang in US Patent No. 5,199,865 in view of Sung in US Patent No. 6,168,420. This rejection is set forth in prior Office Action, Paper No. 5. Claims 9-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liang in US Patent No. 5,199,865 in view of Hefling in US Patent No. 4,870,314. This rejection is set forth in prior Office Action, Paper No. 5. Claims 68-77 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Sung in US Patent No. 6,213,759 as set forth in prior Office Action, Paper No. 10 and further in Paper No. 15.

(11) Response to Argument

In an interview on August 7, 2002, the examiner attempted to assist the appellant define over the prior art of record. However, appellant insists on using

the less precise and broader terminology, such as “sufficiently,” in an attempt to define over that disclosed by Liang and Sung.

The phrases of contention are for claim 1: “***operatively*** associated with the actuating member” and “***capable*** of causing the actuating member to be ***immobilized sufficiently*** to prevent ignition of fuel.”

In response to the arguments of ***immobilized***, as stated on page 4 of the Brief on Appeal, “‘Immobilize’ according to the American Heritage Dictionary, Third Edition, is defined as ‘to render immobile.’” Appellant states, “it is improper for the Examiner to ignore the immobilizing requirement...” However, it is asserted that the Examiner did not ignore the immobilizing requirement, and the invention of Liang “immobilizes” in accordance with the claim and the dictionary definition as provided in the Brief on Appeal in Exhibit 1. When the wand assembly of Liang is in a closed position, the actuating member is immobile/not moving in a manner sufficient to prevent actuation. Therefore, the reason for rejection is substantiated and the definition of the term immobile (immoveable, not moving motionless from Exhibit 1 of the Brief on Appeal) is not unaccounted for in the rejection or contrary to the meaning. If one cannot access the actuation button how can one actuate? In a manner not unlike appellant’s invention, during normal operation of the lighter of Liang, the wand must first be rotated away from the lighter housing to permit unobstructed access to the actuator. In the closed position, the lighter of Liang’s is not intended or designed to provide actuation because the button is concealed. Liang provides for no other placement of the

actuator relative to the wand. Clearly, if the lock is used and the wand is closed, it is not possible to actuate the lighter without rotating the wand; therefore, the actuating member is immobilized sufficiently to prevent actuation. In an interview with appellant's representative on August 7, 2002, it was recommended that appellant positively recite the structural/mechanical features that cause immobilization. However, appellant has chosen not to amend the claims on appeal to clearly define over the prior art of Liang. Therefore, the examiner did, in fact, consider the immobilizing requirement, since immobile means immovable as argued by the appellant. Further, a closer reading of appellant's specification and Brief on Appeal does not alter the examiner's reasonably broad interpretation of the claim language in question. It appears that appellant is attempting to craft claim language that is broader in scope than the best mode disclosed in the specification.

In response to page 5, section 3 of the Brief on Appeal. Appellant contends that the Examiner felt the language of claim 1 is vague and indefinite. It was not Examiner's intent to convey that the claim language is "vague" in the sense of a 35 U.S.C. 112 2nd paragraph rejection. It is believed that claim 1 does not define the invention in a manner sufficient to define over the prior art of Liang and the broad terminology substantiates the rejection given a reasonably broad interpretation.

With regard to the arguments of terms **capable** and **sufficiently**, as stated in Exhibit 1 provided in the Brief on Appeal, **capable** is defined as "having

capacity or ability, efficient and able;" and **sufficiently** is defined as "being as much as needed." The wand of Liang, therefore, in normal operation is capable of causing the actuating member to be immobilized sufficiently to prevent actuation because the wand conceals the actuation button in the closed position. The rejections for the dependent claims are set forth in the prior office actions.

The aspects of contention for claim 68 are "a **conduit** for transporting fuel from the supply to the nozzle ... wherein the conduit **contains** a lead from the ignition assembly for igniting fuel at the nozzle. Again, appellant fails to positively recite structural limitations in the claim that define the invention over the prior art of Sung. The conduit in Sung is considered element 28. It contains the supply of fuel, element 26, and the lead from the ignition assembly, as seen in the Appendix that has been provided for clarity. To reiterate that provided in Exhibit 1 of the Brief on Appeal, the term contain means "to have within." The fuel and the lead are contained within the conduit and the claim language of claim 68 does not preclude that from transporting an additional fuel line or a conduit within a conduit, as in the invention of Sung.

In conclusion, the Examiner agrees with the dictionary definitions as provided in Exhibit 1 of the Brief on Appeal and has attempted to convey how the claims as presented do not define over the prior art of record, specifically Liang and Sung. Furthermore, Examiner has attempted to assist appellant to draft claims that define the invention over that of the prior art.

For the above reasons, it is believed that the rejections should be sustained.

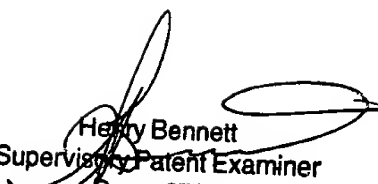
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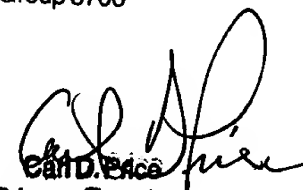
Respectfully submitted,

Kathryn Ferko
March 13, 2003

Conferees
Henry Bennett
Carl Price

PENNIE & EDMONDS LLP
1667 K STREET NW
SUITE 1000
WASHINGTON, DC 20006


Henry Bennett
Supervisory Patent Examiner
Group 3700


Carl Price
Primary Examiner

Kathryn Ferko